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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,170	06/18/2001	Jose Lopez		1435

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EXAMINER

PENDLETON, BRIAN T

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/883,170	
	Examiner	Art Unit
	Brian T. Pendleton	2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 January 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/9/04 have been fully considered but they are not persuasive. Examiner maintains the rejection of claims 1-7, relying on reference to Walters et al.

In response to applicant's argument that the invention is specially designed for studying and for rapid memorization of information, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Walters et al disclose all of the circuit elements recited in the claims. Therefore, the apparatus could be used to memorize questions and answers.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an electronic flag status used to skip audio files, certain audio files cannot be retrieved because the audio files have been memorized by the user, a grading system so that certain files will automatically play or be skipped more or less often based on the progression of the user through the audio files) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The argument that the Walter's invention uses icons and the Applicant's invention does no use icons is not valid. The message number of the Walter et al apparatus is a sequence number. Applicant does not claim a wording content display of the audio file.

Regarding the argument that Walters et al teach a hierarchical memory structure to organize audio recordings, the rejection relies on the feature that the Messages category can be used to record answer and question sets. Therefore, the other levels have nothing to do with the answer and question sets and the rejection does not rely on hierarchical memory structures.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 10, 11, 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. The specification does not describe in detail any embodiments wherein the control functions are activated by voice commands, radio signals or light signals. In addition, Applicant fails to provide support for the questions and answers being displayed on a control screen. Lastly, there is no foundation for the feature that the user can prioritize a question and answer set so that it will replay more or less often as the user desires. While there is support for skipping questions, there is no description of prioritizing certain questions.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 12, 13 and 15 recite the limitation "the question and answer set" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claim. The claims are examined with the assumption that the independent claim 1 makes explicit reference to a question and answer set.

Claims 10, 11 and 14 recite the limitation "the control functions" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim. The claims are examined with the assumption that the independent claim 1 makes explicit reference to the control functions.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walters et al. Walters et al teach a portable audio database device comprising a portable housing 41, microprocessor 120 and memory (see abstract), speaker 48, volume control 82, microphone 46, battery power source 164 (figure 4, per claim 6), record switch 68, play switch 66, rewind switch and forward switch in control panel 64, start/stop switch 70 (column 16 lines 8-9), temporary erase switch 75, permanent erase switch 76, question number display 44, memory use display 101 (per claim 5), inherent on/off switch, headphone jack 84, AC adaptor jack 86 and digital line output jack 144. Taught in the abstract, the memory structure of the device is hierarchical with the level being used for messages. The messages can be a question and answer set. Pressing record while in the Message category will begin recording of a question and answer (column 15 lines 28-47). Regarding claim 4, section 106 of the LCD shows the message number (which qualifies as the question number if questions and answers are being recorded). Column 20 lines 15-17 state that the control panel 64 is used to scroll through the messages allowing the user to skip a question (per claim 2). The button 75 may be used to mark an audio message and move it to another location. Thus, an user

can mark a message in one message category where questions and answers are recorded and move it elsewhere, thereby temporarily deleting it and being able to restore it at a later time. See column 5 lines 30-48. Claim 3 is met since the claim is in alternate form and the reference meets one of the limitations. As to claim 7, there is disclosed external memory module 124 which can be inserted into memory card slots 90 or 92. See column 7 line 58 – column 8 line 8. Per claim 16, the user can use the apparatus for studying and memorization of information by recording questions in the messages folder.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al in view of Pawlowski et al. Walter et al disclose an apparatus comprising a speaker, volume control, microphone, battery power source, record/play switch, rewind switch, forward switch, start/stop switch, temporary erase switch, permanent erase switch, question number display, memory use display, on/off switch, headphone jack, AC adaptor jack and digital line output jack. Walter et al do not disclose that data can be transferred back and forth to a computer. However, such a feature was well known in the art as evidenced by Pawlowski et al. Pawlowski et al teach a digital audio recorder having a bus 60 which connects with a personal computer

16 through parallel data port 66 for transferring data back and forth. It would have been obvious to one of ordinary skill in the art at the time of invention to use that feature in the apparatus of Walters et al for the purpose of permanently saving audio recordings and for subsequent sharing with other users, an advantageous feature. Claim 9 is met. As to claims 12 and 13, column 11 lines 34-42 of Pawlowski et al suggested that wireless RF link and infrared data communication could be used to transfer data to computer 16.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Pendleton whose telephone number is (703) 305-9509. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

3.22-
Brian Tyrone Pendleton
March 26, 2004

[Signature]
MINSUN OH HARVEY
PRIMARY EXAMINER